



PTO/SB/21 (04-07)  
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## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

10

Application Number

10/553,708

Filing Date

June 16, 2006

First Named Inventor

Stefan Bracht

Art Unit

1615

Examiner Name

Attorney Docket Number

RO4101US (#90568)

### ENCLOSURES (Check all that apply)



Fee Transmittal Form



Fee Attached



Amendment/Reply



After Final



Affidavits/declaration(s)



Extension of Time Request



Express Abandonment Request



Information Disclosure Statement



Certified Copy of Priority Document(s)



Reply to Missing Parts/  
Incomplete Application



Reply to Missing Parts  
under 37 CFR 1.52 or 1.53



Drawing(s)



Licensing-related Papers



Petition



Petition to Convert to a  
Provisional Application



Power of Attorney, Revocation



Change of Correspondence Address



Terminal Disclaimer



Request for Refund



CD, Number of CD(s) \_\_\_\_\_

☐ Landscape Table on CD



After Allowance Communication to TC



Appeal Communication to Board  
of Appeals and Interferences



Appeal Communication to TC  
(Appeal Notice, Brief, Reply Brief)



Proprietary Information



Status Letter



Other Enclosure(s) (please identify  
below):

return postcard receipt; translation of  
IPEA/409; and cover Letter

Remarks

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

D. Peter Hochberg Co., L.P.A.

Signature

*Sean F. Mellino*

Printed name

Sean F. Mellino

Date

5/4/07

Reg. No.

48,817

### CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature

*Sean F. Mellino*

Typed or printed name

Sean F. Mellino

Date

05/04/2007

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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MAY 10 2007

PTO/SB/17 (05-07)

Approved for use through 05/31/2007. OMB 0651-0032

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Effective on 12/09/2004.  
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).**FEE TRANSMITTAL**  
**For FY 2007**☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$) 0.00**Complete if Known**

Application Number	10/553,708
Filing Date	June 16, 2006
First Named Inventor	Stefan Bracht
Examiner Name	
Art Unit	1615
Attorney Docket No.	RO4101US (#90568)

**METHOD OF PAYMENT** (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☒ None ☐ Other (please identify): \_\_\_\_\_

☒ Deposit Account Deposit Account Number: 08-2441 Deposit Account Name: D. Peter Hochberg Co., L.P.A.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☐ Credit any overpayments

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES**

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee (\$)	Fee Paid (\$)	Multiple Dependent Claims	Fee (\$)	Fee Paid (\$)
- 20 or HP =	x	=				
HP = highest number of total claims paid for, if greater than 20.						
Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)			
- 3 or HP =	x	=				
HP = highest number of independent claims paid for, if greater than 3.						

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =	/ 50 =	(round up to a whole number) x	250.00	0.00

**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge):

**SUBMITTED BY**

Signature	<i>Sean F. Mellino</i>	Registration No. (Attorney/Agent)	48,817	Telephone	216-771-3800
Name (Print/Type)	Sean F. Mellino	Date			

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Date:

5/4/2007

Sean Mellino

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant : Stefan Bracht

Serial No. : 10/553,708 (Conf. No. 5800)

International App. No.: PCT/EP04/003748

Filing Date : June 16, 2006

Title : Medical Active Substance Patch With Reduced Optical Conspicuousness on the Skin

Art Unit : 1615

Attorney Docket : RO4101US (#90578)

Commissioner for Patents  
P.O Box 1450  
Alexandria, Virginia, 22313-1450

**LETTER**

Dear Sir:

In order to supplement the filing documents of the above-referenced U.S. national phase patent application, enclosed herewith is a translation of the International Preliminary Report on Patentability (PCT/IPEA/409).

Respectfully submitted,

Date:

5/4/2007

Sean F. Mellino  
Reg. No. 48,817

D. Peter Hochberg Co., L.P.A.  
1940 E. 6<sup>th</sup> Street - 6<sup>th</sup> Floor  
Cleveland, OH 44114  
(216) 771-3800

**Translation**

**PATENT COOPERATION TREATY**

**PCT**

**INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY**

(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference <b>LTS 2003/003 PCT</b>	<b>FOR FURTHER ACTION</b>		See Form PCT/IPEA/416
International application No. <b>PCT/EP2004/003748</b>	International filing date (day/month/year) <b>08.04.2004</b>	Priority date (day/month/year) <b>17.04.2003</b>	
International Patent Classification (IPC) or national classification and IPC			
Applicant <b>LTS LOHMANN THERAPIE-SYSTEME AG</b>			

1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 5 sheets, including this cover sheet.

3. This report is also accompanied by ANNEXES, comprising:

a. ☒ (sent to the applicant and to the International Bureau) a total of 3 sheets, as follows:

☒ sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).

☐ sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.

b. ☐ (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) \_\_\_\_\_, containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).

4. This report contains indications relating to the following items:

☒ Box No. I Basis of the report

☐ Box No. II Priority

☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

☐ Box No. IV Lack of unity of invention

☒ Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

☐ Box No. VI Certain documents cited

☐ Box No. VII Certain defects in the international application

☐ Box No. VIII Certain observations on the international application

Date of submission of the demand	Date of completion of this report
Name and mailing address of the IPEA/EP	Authorized officer
Facsimile No.	Telephone No.

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/003748

## Box No. I Basis of the report

1. With regard to the language, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This report is based on translations from the original language into the following language \_\_\_\_\_, which is the language of a translation furnished for the purposes of:
- ☐ international search (Rule 12.3 and 23.1(b))
- ☐ publication of the international application (Rule 12.4)
- ☐ international preliminary examination (Rule 55.2 and/or 55.3)
2. With regard to the elements of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report)*:
- ☐ the international application as originally filed/furnished
- ☒ the description:
- pages 1-16 \_\_\_\_\_ as originally filed/furnished
- pages\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- pages\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- ☒ the claims:
- nos. \_\_\_\_\_ as originally filed/furnished
- nos.\* \_\_\_\_\_ as amended (together with any statement) under Article 19
- nos.\* 1-11 \_\_\_\_\_ received by this Authority on 12.02.2005 with letter
- nos.\* \_\_\_\_\_ received by this Authority on of 10.02.2005
- ☒ the drawings:
- sheets 1/1 \_\_\_\_\_ as originally filed/furnished
- sheets\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- sheets\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- ☐ a sequence listing and/or any related table(s) – see Supplemental Box Relating to Sequence Listing.
3. ☐ The amendments have resulted in the cancellation of:
- ☐ the description, pages \_\_\_\_\_
- ☐ the claims, nos. \_\_\_\_\_
- ☐ the drawings, sheets/figs \_\_\_\_\_
- ☐ the sequence listing (specify): \_\_\_\_\_
- ☐ any table(s) related to sequence listing (specify): \_\_\_\_\_
4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
- ☐ the description, pages \_\_\_\_\_
- ☐ the claims, nos. \_\_\_\_\_
- ☐ the drawings, sheets/figs \_\_\_\_\_
- ☐ the sequence listing (specify): \_\_\_\_\_
- ☐ any table(s) related to sequence listing (specify): \_\_\_\_\_

\* If item 4 applies, some or all of those sheets may be marked "superseded."

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/003748

**Box No. V** Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

## 1. Statement

Novelty (N)	Claims	1-11	YES
	Claims		NO
Inventive step (IS)	Claims	1-11	YES
	Claims		NO
Industrial applicability (IA)	Claims	1-11	YES
	Claims		NO

## 2. Citations and explanations (Rule 70.7)

1. This report makes reference to the following documents:

D1: WO 01/78678 A (JENKINS DELYTH MYFANWY;  
KYTE KENNETH EUGENE (US); PHILLIPS  
JENNIFER E) 25 October 2001

D2: WO 02/34200 A (LOHMANN THERAPIE SYST  
LTS; DEGEN ANJA (DE); THEOBALD FRANK  
(DE) 2 May 2002

D3: US-B-6 361 7901 (ROLF DAVID ET AL) 26  
March 2002

2. The active substance plaster according to claim 1 and the method for the production thereof according to claim 11 are novel in view of the prior art (PCT Article 33(2)). D1 discloses transparent, or at least translucent, inconspicuous active substance plasters (cf. figure 1; page 32, lines 20-22). Said plasters can optionally contain dyes. D1 does not, however, disclose an active substance plaster containing a combination of dyes and ingredients or active

Box No. V

Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

substances that are dyed or change color over time. D2 (cf. page 4, line 33 to page 5, line 5) and D3 (cf. column 6, lines 26-30) likewise each disclose transparent, inconspicuous active substance plasters. D2 discloses a nicotine plaster. The combination of dyes and ingredients that are dyed or change color over time cannot, however, be derived from the disclosure in D2 or D3.

3. The problem to be solved by the present application was that of providing an active substance plaster that masks the coloring or change of color and is also inconspicuous when worn on the skin (cf. description, page 4, lines 1-8). According to the description (cf. page 6, lines 24-36), the problem is solved by providing a transparent or translucent active substance plaster with one (or more) dye(s) that mask the coloring or change in color of the ingredient without compromising the inconspicuousness of the plaster on the skin. The inconspicuousness of the plaster is described by the functional feature (cf. color brightness value) included in claim 1. This solution to the problem of interest is neither suggested nor rendered obvious by the teaching in D1-D3. Therefore, the claimed subject matter also involves an inventive step pursuant to PCT Article 33(3).

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

International application No.

PCT/EP2004/003748

Box No. V

Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability;  
citations and explanations supporting such statement

4. Claims 2-10 are dependent on claim 1 and therefore likewise meet the PCT requirements for novelty and inventive step.
5. The subject matter of claims 1-11 is regarded as industrially applicable and therefore meets the requirements of PCT Article 33(4).